



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,094	12/03/2003	Floyd Randolph Simonds	2001-IP-005937 UIC1 USA	8762
32376	7590	03/20/2006	EXAMINER BOMAR, THOMAS S	
LAWRENCE R. YOUST DANAMRAJ & YOUST, P.C. 5910 NORTH CENTRAL EXPRESSWAY SUITE 1450 DALLAS, TX 75206			ART UNIT 3672	PAPER NUMBER

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,094

Applicant(s)

SIMONDS ET AL.

Examiner

Shane Bomar

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-23,25-34 and 36-41 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,14-22,32 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,9-13,23,25,27-31,33,34,37,38,40 and 41 is/are rejected.
- 7) ☒ Claim(s) 8,26 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-7, 9-13, 23-25, 27-31, 33-35, 37, 38, 40, and 41 are rejected under 35

U.S.C. 102(b) as being anticipated by US patent 5,667,023 to Harrell et al.

Regarding claims 1, 2, 5-7, 11, 12, 23-25, 29, 30, 33-35, 37-38, and 41, Harrell et al disclose a method of completing a wellbore while drilling, and associated apparatus, comprising the steps of: disposing a drill bit 54 on an end of a drill string, the drill string being composed of string 20 that is connected to rotor/stator assembly 60 that is connected to drive shaft 90, which is ultimately attached to the bit 54; positioning a completion assembly 30, including a sand control screen and a gravel packing apparatus, around a section of the drill string, the section of drill string being at least the rotor/stator 60; establishing a fluid seal 92 and a rotatable coupling between the completion assembly and the drill string to prevent fluid migration and torque transfer therebetween; extending the wellbore by rotating the drill bit with the assembly 60 and advancing the drill string from the surface beyond the end of a casing 50 in the wellbore without rotating the completion assembly; ceasing the advancement of the drill string when the completion assembly has reached a desired depth; supportably coupling the completion assembly to the casing with a suspension tool 82; disconnecting the drill string from the drill bit; retrieving the drill string to the surface leaving the completion assembly and the drill bit downhole; and

Art Unit: 3672

gravel packing the wellbore around the sand control screen and the gravel packing apparatus (see Fig. 6 and col. 10, lines 8-52).

Regarding claims 9, 10, 27, 28, and 40, a downhole motor 60 rotates the drill bit (see Fig. 6), while, during steering operations, the drill bit can be rotated by string 20 (see, for example, col. 9, lines 21-23).

Regarding claims 13 and 31, a production tubing is installed relative to the completion assembly (see, for example, col. 10, lines 4-7).

Allowable Subject Matter

3. Claims 8, 26, and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. , Applicant's arguments, see page 19, filed March 1, 2006, with respect to claims 8, 26, and 39 have been fully considered and are persuasive. The 35 USC 102(b) rejection of those claims has been withdrawn.

5. Applicant's arguments filed March 1, 2006, pertaining to the remaining claims not mentioned immediately above, have been fully considered but they are not persuasive. It is argued that the completion assembly is not disposed around a section of the drill string. However, the components 20, 60, and 90 are taken together as a whole and make up a drill string extending from the surface to the bit because a drill string is known to be used to rotate a drill

Art Unit: 3672

bit, which this assembly does. Even barring taking these components as a whole to make a string, a top portion 78 of the completion assembly in Figure 6 is clearly disposed around a section of the drill string 20, albeit a very small section. This string is also clearly advanced from the surface because there would be no other way of getting the string and the bit into the hole. Finally, the drill string components 20, 60, and 90 are removed from the wellbore leaving only the completion assembly 30 and the bit 54 (see, for example, Fig. 7B and col. 10, lines 46-48).

It must also be noted that the limitation "from the surface" added to the independent claims suggests that only the drill string is advanced from the surface. If it was the Applicant's intent to state that both the rotation of the drill bit and the advancement of the drill string is from the surface, then further amendment would be required to positively convey this concept. However, this would lead to indefiniteness problems with dependent claims 9, 27, and 40 that provide the limitation of rotating the drill bit by a downhole motor. The drawings and specification do support rotating the bit from both the surface and with a motor, but the current wording of claims 9, 27, and 40 would appear to preclude rotation from the surface and with the downhole motor. A possible solution would be to simply add --additionally-- after the word "comprises" and before the word "rotating" in each claim.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb



March 16, 2006